

REMARKS

Status

The present application was filed on August 1, 2001. The application is directed, in-part, to compositions comprising roasted and ground (herein “R&G”) coffee in combination with previously processed coffee grounds (herein “PCGs”) that are useful in preparing coffee beverages, coffee extracts and coffee concentrates.

The application was originally filed with 23 claims. In the present response, Applicants request amendments to Claims 1 and 10, and the entry of new Claim 24. Support for the Claim 1 and Claim 10 amendments is found, for example, at the paragraph spanning pages 4 and 5 of the specification. Support for newly added Claim 24 (which is within Group I of the Examiner’s prior restriction requirement) is found at page 6, lines 16-18. No new matter is added. Claims 12-23 have been withdrawn from consideration in view of an earlier restriction requirement. However, Applicants again request withdrawal of the requirement and the examination of Claims 1-24.

The Examiner’s Restriction Requirement

The Examiner makes Final the restriction requirement first set forth on October 3, 2003. In realizing that the prior basis for restricting was improper based on the subject matter subsumed by the Group II claims, the Examiner now provides new grounds for the requirement.

Before moving to the substantive grounds for traversing the requirement, Applicants first want to address the appropriateness of making the requirement final. Obviously the Examiner realized that the initial basis (MPEP 806.05(h), paragraph (1)) for making the requirement was improper. Thus, this is the first opportunity Applicants have had to traverse the requirement based on the new grounds. Applicants respectfully request that the Examiner consider Applicants’ present traversal of the requirement.

The Examiner now relies on paragraph (2) of MPEP 806.05(h), asserting that “the ground coffee and used grounds product may be used in preparing another food product, for example, using same in a dessert topping (e.g. with chocolate) or as an ingredient in specialty candies.” Applicants respectfully submit that it is not seen how the compositions of Claims 1-11, which comprise roasted and ground coffee in combination with processed coffee grounds, could be used in a dessert topping or as an ingredient in specialty candies that would be deemed palatable by consumers. Moreover, as will be discussed below, all of Claims 1-11 are directed to “compositions for preparing *brewed coffee beverage[s]*...” (emphasis added). Per the specification at page 4, lines 3-8, the term brewed coffee beverage refers to “a liquid beverage that is intended for consumption without further processing, other than manipulation by the end

consumer (e.g., addition of flavors, creams, sweeteners, or the like).” Thus, the claims of Group I are directed to compositions for making a coffee beverage and not to compositions that are used to make other products, such as toppings or candy.

Based on a full reading of the claims in view of the specification, the Examiner’s assertion that the compositions of Group I can be used in the manner articulated as an alternative use is improper. As such, Applicants again submit that requiring restriction between Groups I and II is improper. Applicants therefore request withdrawal of the restriction requirement.

#### The Examiner’s Prior Art Rejections

The Examiner has rejected Claims 1, 5, 6 and 8-10 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,328,709 (“Rizzi”). Claims 1-4 have also been rejected under 35 U.S.C. 102(b) as being anticipated by Canadian Patent 1,032,825 (“Katz”). Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over Rizzi alone (Claim 7) or Rizzi in view of additional references (Claim 11).

Because Applicants are of the view that the clarifying amendment to Claims 1 and 10 removes Rizzi as a relevant reference, the Section 102 and 103 rejections based on Rizzi will be addressed together; the rejection over Katz is discussed separately.

##### A. Rejections Over Rizzi

In rejecting Claims 1, 5, 6 and 8-10 under Section 102(b), the Examiner discusses portions of Rizzi that allegedly disclose the ratio of R&G coffee to PCGs, the types of R&G coffee used, and the moisture content of the PCGs employed, all properties called out in dependent claims. The Examiner also asserts that Rizzi teaches the incorporation of soluble coffee particles together with R&G coffee and spent grounds (i.e., the subject matter of independent Claim 10). However, the Examiner does not indicate why independent Claims 1 and 10 are anticipated in the first instance. Because the Examiner has not rejected dependent Claims 2-4 over Rizzi, which are narrowed only in terms of the amount of lipids contained in the PCG aspect of the compositions, Applicants assume that the Examiner has not considered that Claim 1 and Claim 10 also have a lipid element, although it is not specifically called out in those claims. In the “Definitions” section at page 5, lines 1-2, Applicants indicate that processed coffee grounds or PCGs “will comprise greater than 2% lipids.” As such, in using the term “PCG” in the claims, Applicants mean that the PCGs will comprise greater than 2% lipids. However, based on this interpretation of the Examiner’s anticipation rejection over Rizzi, Applicants have amended Claims 1 and 10 to further clarify that the PCGs employed in the claimed compositions have greater than 2% lipids. As Rizzi clearly does not describe such compositions, Applicants submit that the anticipation rejection should be withdrawn.

Applicants further submit that Rizzi clearly does not suggest compositions containing R&G coffee in combination with PCGs having a lipid content greater than 2%. Indeed, the entire essence of Rizzi is the use of defatted coffee grounds. See, e.g., Col. 3, lines 36-38 and Col. 7, lines 36-39. Rizzi suggests that reduction of the lipid content to as close to zero as possible is preferred. As such, there is no motivation in Rizzi's teachings to combine the PCGs described in the present application with R&G coffee to make a composition for preparing brewed coffee beverages. Indeed, Rizzi clearly teaches away from the subject matter of Applicants' claims.

Based on the foregoing, Applicants request the allowance of Claims 1, 5, 6 and 8-10 in view of Rizzi. Furthermore, because the rejections under Section 103(a) of Claims 7 and 11 are based on Rizzi as the primary reference, Applicants submit that for the foregoing reasons, Rizzi does not teach the subject matter of these dependent claims. Withdrawal of the obviousness rejection of Claims 7 and 11 is therefore requested.

B. Rejection Over Katz

Claims 1-4 are rejected as being anticipated by Canadian Patent 1,032,825 to Katz. The Examiner states that Katz

discloses a composition for preparing a brewed coffee beverage wherein said composition comprises roasted, ground coffee and processed coffee grounds and wherein said processed coffee grounds would inherently possess the lipids required to meet the limitations called for in instant claims 2-4 because there is no defatting step employed for said coffee grounds.

(In passing, Applicants again note that the Examiner did not mention the lipid content of Claim 1; this further suggests to Applicants that the Examiner did not consider that the term Processed Coffee Grounds means, per the specification, that they include more than 2% lipids. Thus, the amendment to Claims 1 and 10 to clarify this point should address the anticipation rejection over Rizzi.)

The Katz disclosure is directed generally to a process for obtaining soluble coffee powder. See, e.g., page 1, lines 1-4. (This soluble coffee is commonly referred in the field as "instant coffee.") In general, this process involves the extraction of R&G coffee from successive extraction columns, wherein the final extract is eventually processed into a dried, soluble coffee powder for sale as instant coffee. The emphasis of Katz's teachings is on the use of an inert material in the plurality of columns used in the extraction process. In particular, Katz teaches that the percolation yield can be improved if the R&G coffee to be extracted is located between the fluid distributors positioned at the top and bottom of each extraction column, while portions of the columns above and below these distributors is packed with an inert material. See paragraph spanning pages 2 and 3. Although several "packing materials" are described, Katz indicates that a useful material is spent coffee grounds.

Appl. No. 09/920,200  
Atty. Docket No. 8654  
Amtd. dated March 5, 2004  
Reply to Office Action of February 2, 2004  
Customer No. 27752

It is clear that Katz utilizes processed coffee grounds in a manner very different from Applicants' use in the compositions of Claims 1-11. Indeed, it is important to recognize that, in addition to other terms defining the compositions of Claims 1-11, Applicants use the term "brewed coffee beverage" to describe the claimed compositions. With proper reference to the specification, this term is stated to refer to "a liquid beverage that is intended for consumption *without further processing, other than manipulation by the end consumer* (e.g., addition of flavors, creams, sweeteners, or the like)." See page 4, lines 5-8 (emphasis added). Accordingly, while properly reading the claims in light of the specification, it is clear that the materials described by Katz are in no way related to a composition for preparing a "brewed coffee beverage." In fact, to the extent Katz is interpreted to describe a "composition comprising R&G coffee and PCGs," that composition is clearly one that results in the formation of an extract that is subsequently processed into soluble or instant coffee. This is not the subject matter subsumed by Claims 1-11. As such, Applicants request that the Examiner withdraw the Section 102(b) rejection of Claims 1-4 over Katz.

#### Conclusions

Applicants have addressed the Examiner's new grounds for maintaining the restriction requirement and have requested that the Examiner reconsider the finality of the requirement. Applicants have also made a clarifying amendment to Claims 1 and 10 to more clearly indicate the threshold level of lipids present in the processed coffee grounds aspect of the claims. This amendment addresses the rejections over the Rizzi patent. Finally, Applicants have pointed out that proper interpretation of the claims in view of the specification clearly establishes that Claims 1-11 do not subsume the materials described in the Katz patent.

Applicants request the withdrawal of the restriction requirement and the allowance of Claims 1-24.

Respectfully submitted,

By Carl J. Roof  
Carl J. Roof  
Attorney for Applicants  
Registration No. 37,708  
(513) 634-5209

*6 CTR*  
Date: March 5, 2004

Customer No. 27752